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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,878	11/12/2003	Andreas Leukert-Knapp	13906-115US2 / 2001P00007	6758
32864	7590	08/24/2007	EXAMINER	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			TRAN, PHILIP B	
			ART UNIT	PAPER NUMBER
			2155	
			MAIL DATE	DELIVERY MODE
			08/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/706,878	<b>Applicant(s)</b> LEUKERT-KNAPP ET AL.	
	<b>Examiner</b> Philip B. Tran	<b>Art Unit</b> 2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **Response to Amendments**

### ***Notice to Applicant***

1. This communication is in response to Amendment filed 11 June 2007. Claims 20-21 and 32-43 have been amended. Therefore, claims 20-43 are pending for further examination.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 20 and 32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had possession of the invention on the filing date of the application.

The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 20 and 32:

- "... the distribution list being generated, **without requiring users to select notification messages they are to receive**, by identifying, from stored application-to-role assignment information and from stored user-to-role assignment information..."

Applicant does not cite anywhere in the present application specification indicating that "...**without requiring users to select notification messages they are to receive**, by identifying, from stored application-to-role assignment information and from stored user-to-role assignment information..." Thus it is unclear how the present specification can support the claimed limitations "...**without requiring users to select notification messages they are to receive**, by identifying, from stored application-to-role assignment information and from stored user-to-role assignment information..." in claims 20 and 32.

Therefore, claims 20 and 32 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

(2) Claims 20 and 32 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 20 and 32:

- "... the distribution list being generated, **without requiring users to select notification messages they are to receive**, by identifying, from stored

application-to-role assignment information and from stored user-to-role assignment information..."

Undue experimentation would be needed to implement **without requiring users to select notification messages they are to receive.**

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 20-26, 28-38 and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Faour et al (Hereafter, Faour), U.S. Pat. No. 6,857,017.

Regarding claim 20, Faour teaches a method for issuing notification messages to users of a computer network [see Abstract], the method comprising:

creating, within a notification message distribution component, a distribution list of a first group of users to receive notification messages pertaining to a specified one of multiple different business computer applications, the distribution list being generated, without requiring users to select notification messages they are to receive, by identifying, from stored application-to-role assignment information and from stored user-

to-role assignment information, users having a pre-assigned role that is a pre-assigned role for the specified one business computer application, wherein the stored application-to-role assignment information and the stored user-to-role assignment information define which of the multiple different business computer applications a user is allowed to access (= list of users with role-to-user assignment associated with having event messages corresponding to elements (applications) such as business objects and batch jobs wherein each user in the list has access to information based on the user's role) [see Abstract and Figs. 1-2 & 6-7 and Col. 5, Line 63 to Col. 6, Line 20 and Col. 7, Line 35 to Col. 8, Line 8]; and

receiving, at the notification message distribution component, a message indicating that a current value of a predetermined variable in the specified one business computer application is in a predetermined relation to a reference value and issuing, from the notification message distribution component, a first notification message to a communication device corresponding to each user in the first group (= a user may have certain notifications (alerts) sent to their desktops by registering for selected events and groups of events) [see Abstract and Figs. 1 & 6 and Col. 6, Line 21 to Col. 7, Line 28].

Regarding claim 21, Faour further teaches the method of claim 20, further comprising issuing, from the notification message distribution component, a further notification message to a communication device corresponding to a further user outside the first group of users in the event that during a predetermined time period no user

from the first group has confirmed reception of the first notification message [see Col. 5, Lines 23-58 and Col. 7, Lines 15-20].

Regarding claim 22, Faour further teaches the method of claim 21, wherein reception of the first notification message is confirmed when one or more users from the first group returns a receipt message (= acknowledgment by a user) [see Col. 6, Lines 53-56].

Regarding claim 23, Faour further teaches the method of claim 22, further comprising assigning a unique identification number to the first notification message such that the communication device returns the identification number as part of the receipt message [see Col. 4, Line 59 to Col. 5, Line 7].

Regarding claim 24, Faour further teaches the method of claim 21, wherein the further notification message has a description portion to indicate being the further notification [see Col. 4, Lines 19-27 and Col. 5, Lines 23-58 and Col. 7, Lines 15-20].

Regarding claim 25, Faour further teaches the method of claim 21, wherein the further user has a supervisory relationship with the first group of users (= event handler or alert manager) [see Col. 3, Lines 25-52 and Col. 5, Lines 23-58].



Regarding claim 26, Faour further teaches the method of claim 20, wherein the first notification message is issued to the communication device such that the communication device visually presents the first notification message [see Abstract and Col. 1, Line 65 to col. 2, Line 7].

Regarding claim 28, Faour further teaches the method of claim 26, wherein the communication device visually presents the first notification message as a hyperlink to a full version of the first notification message (= dashboard window includes a hyperlink) [see Col. 6, Line 41 to Col. 7, Line 6].

Regarding claim 29, Faour further teaches the method of claim 20, wherein the distribution list is created after detecting that the current value of predetermined variable in the business application is in the predetermined relation to a reference value [see Abstract and Figs. 1-2 & 6-7 and Col. 5, Line 63 to to Col. 7, Line 28 and Col. 7, Line 35 to Col. 8, Line 8]

Regarding claim 30, Faour further teaches the method of claim 20, wherein the application-to-role assignment includes an alert-type-to-role assignment [see Figs. 6-7 and Col. 5, Line 63 to Col. 7, Line 14].

Claims 32-38 and 40-42 are rejected under the same rationale set forth above to claims 20-26 and 28-30, respectively.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faour et al (Hereafter, Faour), U.S. Pat. No. 6,857,017 in view of Zothner, U.S. Pat. No. 6,751,657.

Regarding claim 27, Faour does not explicitly teach wherein the communication device is a personal computer with electronic mail. However, Zothner, in the same field of notifications based on user role endeavor, discloses a communication device (computers) involves with receiving notifications such as e-mail [see Zothner, Col. 2,

Lines 15-25 and Col. 22, Lines 25-65]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Zothner into the teaching of Faour in order to efficiently facilitate notifications between devices by reducing the time for communication.

Claim 39 is rejected under the same rationale set forth above to claim 27.

Regarding claim 31, Faour does not explicitly teach receiving subscription requests to selectively add or remove individual users to or from the distribution list. However, Zothner, in the same field of notifications based on user role endeavor, discloses selectively add or remove individual users (customers) from the subscription list [see Zothner, Col. 4, Line 62 to Col. 5, Line 12 and Col. 22, Line 25 to Col. 23, Line 12]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Zothner into the teaching of Faour in order to efficiently facilitate notifications between devices by updating the information regarding availability and reliability of network elements.

Claim 43 is rejected under the same rationale set forth above to claim 31.

### ***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive because of the following reasons:

A/ Applicant argued that provisional double patenting with co-pending application No. 10/469,336 is no longer valid [see Remark on page 8].

In response to applicant's argument, a provisional double patenting with co-pending application No. 10/469,336 has been withdrawn because the claim sets for application No. 10.469,336 have been changed by preliminary amendment.

B/ Applicant argued that claim rejection 35 USC 101 is no longer valid [see Remark on Pages 8-9].

In response to applicant's argument, claim rejection 35 USC 101 has been withdrawn because applicant has amended to exclude propagated signal and paper from the claims and the specification of the instant application.

C/ Applicant argued that Faour does not disclose or suggest the subject matter of applicant's claim 20 [see Remark on Pages 10-11].

In response to applicant's argument, Faour teaches creating, within a notification message distribution component, a distribution list of a first group of users to receive notification messages pertaining to a specified one of multiple different business computer applications, the distribution list being generated, without requiring users to select notification messages they are to receive, by identifying, from stored application-to-role assignment information and from stored user-to-role assignment information, users having a pre-assigned role that is a pre-assigned role for the specified one business computer application, wherein the stored application-to-role assignment

information and the stored user-to-role assignment information define which of the multiple different business computer applications a user is allowed to access. For example, Faour discloses generating a list of users with role-to-user assignment associated with having event messages corresponding to elements (applications) such as business objects and batch jobs wherein each user in the list has access to information based on the user's role [see Abstract and Figs. 1-2 & 6-7 and Col. 5, Line 63 to Col. 6, Line 20 and Col. 7, Line 35 to Col. 8, Line 8].

Moreover, applicant does not cite anywhere in the present application specification indicating that "...**without requiring users to select notification messages they are to receive**, by identifying, from stored application-to-role assignment information and from stored user-to-role assignment information..." Thus it is unclear how the present specification can support the claimed limitations "...**without requiring users to select notification messages they are to receive**, by identifying, from stored application-to-role assignment information and from stored user-to-role assignment information..." in claims 20 and 32. Therefore, claims 20 and 32 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claimed limitations.

Faour discloses that the users register for selected events and groups of events not to select notification messages as argued by applicant. Instead, Faour clearly discloses automatically sending notifications directly from an application to a user when selected events occur [see Faour, Col. 1, Lines 44-46].

Therefore, the examiner asserts that the cited prior arts teach or suggest the subject matter recited in independent claims. Dependent claims are rejected at least by virtue of their dependency on independent claims and by other reasons set forth above. Accordingly, claims 20-43 are respectfully rejected as shown above.

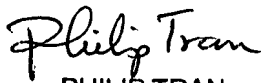
***Conclusion***

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

**A SHORTENED STATUTORY PERIOD FOR REPLY TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS ACTION. IN THE EVENT A FIRST REPLY IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CAR 1.136(A) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT, HOWEVER, WILL THE STATUTORY PERIOD FOR REPLY EXPIRE LATER THAN SIX MONTHS FROM THE MAILING DATE OF THIS FINAL ACTION.**

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
PHILIP TRAN  
PRIMARY EXAMINER  
Art Unit 2155  
August 14, 2007